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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,897	07/25/2001	Kosei Terada	393032003810	7946

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MORRISON & FOERSTER, LLP  
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EXAMINER

CALLAHAN, PAUL E

ART UNIT PAPER NUMBER

2137

DATE MAILED: 12/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/912,897

**Applicant(s)**

TERADA ET AL.

**Examiner**

Paul Callahan

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 24-27, 29-34, 37-41, 52 and 54-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 29-31, 34, 39-41 and 54-58 is/are allowed.
- 6) ☐ Claim(s) 24, 26 and 27 is/are rejected.
- 7) ☐ Claim(s) 25, 32, 33, 37, 38 and 52 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. The Applicant notified the Office of an error in the previous Office Action requiring correction and issuance of a new Office Action. Since the notification was made within one month of the mail date of the previous Office Action, the time period for response has been restarted in full with the mail date of the instant Office Action. See MPEP 710.06[R-3].

2. Claims 24-34, 37-41, 52, and 54-59 were pending at the time of the previous Office Action. By the amendment filed 7-27-06, claims 28 and 59 are now cancelled. Therefore claims 24-27, 29-34, 37-41, 52, and 54-58 are pending and have been examined.

### ***Response to Arguments***

3. Applicant's arguments have been fully considered and, when taken together with the changes made to the language of the claims by the latest amendment, are persuasive to overcome the rejections of the claims as found in the previous Office Action.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 24, 26, and 27 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1, 3, 23, and 24 of U.S. Patent No. 7,015,388.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they each claim identical methods for changing electronic information where first information and second information indicative of an information change scheme are input, where the second information is embedded dispersedly into said first information by changing the contents of at least part of the first data on the basis of the second information. The claims of the Patent do not explicitly recite the final limitation of claims 24, 26 and 27 of changing a portion of the first information where said second information is not positioned, in accordance with the information change scheme indicated by said second information. However, claims 1, and 23 of the Patent do teach that "*at least one data unit of the first data*" is embedded, and therefore these claims of the Patent do teach the feature of less than all of the first data being embedded. Claims 3 and 23 of the Patent teach a change of format that does not operate on all of the first data, and which is taught as encryption in these claims. The Examiner considers these features of claims 1, 3, 23, and 24 of the Patent to read on the final limitation of claims 24, 26, and 27 of the instant application. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to explicitly incorporate the step of changing a portion of a first

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information where said second information is not positioned. It would be desirable to do so as this would allow more rapid recovery of the second information and hence recovery of the transformed first information as well.

*Allowable Subject Matter*

6. Claims 29-31, 34, 39-41, 54-58 are allowed.
7. Claims 25, 32, 33, 37, 38, and 52 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
8. The following is an examiner's statement of reasons for allowance: The closest prior art in the field, Barton US 6,646,997, and Rosenberg US 6,636,357, do not teach the combination of features found in the independent claims, particularly including:

As for independent claims 29, 30, and 31, the step of changing a portion of the first information, where the second information is not embedded, in accordance with the information change scheme indicated by the second information. Claims 34 and 39-41 are dependent on claim 29 are thereby allowable on that basis.

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As for claims 54, 55, 57 and 58, the use of a tone pitch parameter to change the first data, in the manner of the applicant. Claim 56 is dependent on claim 55 and is thereby allowable on that basis.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Conclusion***

89. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (571) 272-3869. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Emmanuel Moise, can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is: (571) 273-8300.

11-14-06

*Paul Callahan*

*Emmanuel L. Moise*  
EMMANUEL L. MOISE  
SUPERVISORY PATENT EXAMINER